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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,078	12/11/2003	Dieter Wenninger	101769-242/tesa AG 1623-W	8479
27386	7590	03/08/2006	EXAMINER DESAI, ANISH P	
NORRIS, MCLAUGHLIN & MARCUS, P.A. 875 THIRD AVE 18TH FLOOR NEW YORK, NY 10022			ART UNIT 1771	PAPER NUMBER

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/733,078

Applicant(s)

WENNINGER ET AL.

Examiner

Anish Desai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. The applicant's arguments in response to the Office action dated 09/23/05 have been fully considered.
2. The 35 USC 112 rejections are withdrawn.
3. All of the art rejections are withdrawn. However, upon further consideration a new ground of rejection is made in view of Hauber (Derwent Abstract of DE 4228436A1).

### *Claim Rejections - 35 USC § 102/103*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1,4,5-7,10,12,and 13 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hauber (Derwent Abstract of DE 4228436A1).

Hauber teaches pressure sensitive adhesive mixture in the form of aqueous dispersion comprising acrylic acid and styrene wherein the styrene is added in the amount of from 0.5 to 35 wt%, especially in the amount of from 1 to10 wt%. The

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adhesive is coated onto one or both sides of plasticized polyvinyl chloride sheet. The invention of Hauber is useful as adhesive sheets or tapes. With respect to the claim limitation of migration of the plasticizers from the sheet into the adhesive, although Hauber does not explicitly teach that the plasticizers migrate from the polyvinyl chloride sheet into the adhesive, it is reasonable to presume that the plasticizers in the PVC sheet of Hauber will necessarily migrate into the adhesive. Support for said presumption is found in the use of like materials. The adhesive tape of the applicant comprises a sheet of plasticized polyvinyl chloride and an aqueous adhesive dispersion comprising styrene-acrylic acid copolymers wherein styrene fraction is from 10 to 70% by weight. The pressure sensitive adhesive tape of Hauber also comprises a plasticized polyvinyl chloride sheet that is coated with an aqueous adhesive dispersion comprising acrylic acid and styrene. Further, the adhesive of Hauber comprises styrene in the amount of from 0.5 to 35 wt%. The applicant is also claiming styrene weight fraction of 10% to 70%. Thus, the amount of styrene disclosed by Hauber meets the claimed amount of styrene as claimed in the claim 1. Therefore, the adhesive tape disclosed by the Hauber is similar to the adhesive tape of the applicant as claimed in the claim 1. Moreover, with respect to the recitation "plasticizer migrated from the sheet into the adhesive", the applicant is reminded that article claims must be structurally distinguishable from the prior art. While features of an article may be recited either structurally or functionally, claims directed to an article must be distinguished from the prior art in terms of structure rather than function.

With respect to claim 4, although Hauber does not disclose the thickness of the plasticized polyvinyl chloride sheet, it is well known in the art to use the polyvinyl chloride sheet having the thickness in the claimed range of 50 to 200  $\mu\text{m}$  as evidenced by US 5,716,701 to Skoglund et al.

With respect to claims 5-7, the term "up to" as recited in claims 5-7 means that the adhesive layer can also contain 0% by weight of resin dispersion, plasticizer, and oil. Therefore the prior art adhesive does not have to contain the resin dispersion, dispersion, and plasticizer and oil as claimed in claims 5-7 respectively. Thus, the disclosure of Hauber meets the claim limitations of claims 5-7.

With respect to claim 10, the recitation "adhesive is crosslinked by chemical, thermal, or radiation treatment" is directed to product by process limitation. The products by process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. "Even though product by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art

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product. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983). In the instantly claimed subject matter, the adhesive tape comprises a sheet of plasticized polyvinyl chloride and an aqueous based adhesive dispersion of styrene-acrylic acid copolymers having styrene fraction of from 10 to 70% wherein the plasticizers have migrated from the plasticized polyvinyl chloride sheet into the adhesive. The pressure sensitive adhesive tape of Hauber also comprises a plasticized polyvinyl chloride sheet that is coated with an aqueous adhesive dispersion comprising acrylic acid and styrene. Further, the adhesive of Hauber comprises styrene in the amount of from 0.5 to 35% by weight. The adhesive applicant is also claiming styrene weight fraction of 10% to 70% by weight. Thus the adhesive tape disclosed by the Hauber is similar to the adhesive tape of the applicant.

With respect to claims 12 and 13, it is the examiner's position that the adhesive tape of Hauber is functionally capable of bunding, protecting, labeling, insulating or sealing ventilation pipes or wires or cables as claimed in the claim 12 and functionally capable of being used in sheathing of cable looms and filed coils as claimed in the claim 13 in view of the above mentioned teachings of Hauber with respect to claim 1.

5. Claims 1 and 5-7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Czerepinski et al. (US 4,713,412).

Czerepinski teaches an emulsion polymerized pressure sensitive adhesive composition that is used to manufacture articles such as tapes, decals, and decorative vinyl sheet (Column 4, lines 16-17). Further as shown in the Example III of Czerepinski, the pressure sensitive adhesive composition of Czerepinski comprises 35 wt% styrene

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and 3 wt% acrylic acid. At column 4, lines 7-11, Czerepinski teaches that the pressure sensitive adhesive composition adheres well to the resin surfaces such as plasticized polyvinyl chloride.

With respect to the claim limitation of migration of the plasticizers from the sheet into the adhesive, although Czerepinski does not explicitly teach that the plasticizers migrate from the polyvinyl chloride resin surface into the adhesive, it is reasonable to presume that the plasticizers in the plasticized polyvinyl chloride resin surface of Czerepinski will necessarily migrate into the adhesive. Support for said presumption is found in the use of like materials. The adhesive tape of the applicant comprises a sheet of plasticized polyvinyl chloride and an aqueous adhesive dispersion comprising styrene-acrylic acid copolymers wherein styrene fraction is from 10 to 70% by weight. The pressure sensitive adhesive tape of Czerepinski also comprises a plasticized polyvinyl chloride resin surface that can be coated with the pressure sensitive adhesive composition comprising acrylic acid and styrene. Further, the pressure sensitive adhesive of Czerepinski comprises 35 wt% of styrene. The applicant is also claiming styrene weight fraction of 10% to 70%. Thus, the amount of styrene disclosed by Czerepinski meets the claimed amount of styrene as claimed in the claim 1. Therefore, the adhesive tape disclosed by the Czerepinski is similar to the adhesive tape of the applicant as claimed in the claim 1. Moreover, with respect to the recitation "plasticizer migrated from the sheet into the adhesive", the applicant is reminded that article claims must be structurally distinguishable from the prior art. While features of an article may

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be recited either structurally or functionally, claims directed to an article must be distinguished from the prior art in terms of structure rather than function.

With respect to claims 5-7, the term "up to" as recited in claims 5-7 means that the adhesive layer can also contain 0% by weight of resin dispersion, plasticizer, and oil. Therefore the prior art adhesive does not have to contain the resin dispersion, dispersion, and plasticizer and oil as claimed in claims 5-7 respectively. Thus, the disclosure of Czerepinski meets the claim limitations of claims 5-7.

6. Claims 3,8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hauber (Derwent Abstract of DE 4228436A1) in view of Schwarcz (US 4,002,794).

The invention of Hauber as applied to claim 1 is previously disclosed. Hauber is silent as to teaching of adhesive is applied to the PVC sheet in the amount of 10 to 50 g/m<sup>2</sup> as claimed in the claim 3, a primer as claimed in the claim 8, and a release layer as claimed in the claim 9. However, Schwarcz teaches novel copolymeric materials suitable for use as a release agent or as a component in a release composition, and to methods of their preparation. In more particularly the invention relates to coated substrates having a surface coated therewith such as release liner and pressure sensitive adhesive tapes (Column 1, lines 6-13). With respect to the claim 3, the weight of the pressure sensitive adhesive composition of Schwarcz is in the range of between about 0.5 to 4 ounces per square yard of backing member (Column 12, lines 33-36) which equates to 16.95 grams per square meter to 136 grams per square meter (using 1 ounce = 28.35 grams and 1 square yard = 0.836 square meter). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made



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to apply the adhesive of Hauber using the disclosed weight of Schwarcz on the plasticized polyvinyl chloride sheet of Hauber, motivated by the desire to form the pressure sensitive adhesive tape.

Regarding the claim 8, Schwarcz teaches a primer coating on the backing before the adhesive composition is applied to the backing (Column 12, lines 17-20) in order to improve the surface bonding characteristic of the backing to the pressure sensitive adhesive (Column 11, lines 16-20). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the primer layer of Schwarcz on the plasticized polyvinyl chloride sheet of Hauber before the application of adhesive, motivated by the desire to improve the bonding between the adhesive and the plasticized polyvinyl chloride sheet.

With respect to the claim 9, Schwarcz teaches that a coating known as release coat or back size is generally provided on the back side of the tape backing member i.e. the side opposite that on which the adhesive mass is applied in order for easy to unwind the tape when it is provided in the roll form (Column 1, lines 15-28). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a release coating of Schwarcz in the pressure sensitive adhesive tape of Hauber, motivated by the desire to prevent the adhesive from sticking to the surface of the backing that is facing the adhesive when the tape is in the rolled form.

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hauber (Derwent Abstract of DE 4228436A1) in view of Glennon (US 4,311,759).

The invention of Hauber as applied to claim 1 is previously disclosed. Hauber is silent as to teaching of adhesive comprising antifoams, ageing inhibitors, and wetting agents. However, Glennon teaches a pressure sensitive adhesive composition comprising anti-oxidants (i.e. ageing inhibitors) to avoid the degradation of adhesive by oxidation (Column 6, lines 55-56), antifoam agent to prevent the degradation of the adhesive (Column 5, lines 65-68, column 6, lines 1-5), and a surface active agent (i.e. surfactants) to improve the substrate or carrier wetting (Column 7, lines 8-13). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add the anti-oxidants, antifoam agents, and surface active agents of Glennon, motivated by the desire to prevent the degradation of the adhesive and to improve the substrate wetting.

### ***Response to Arguments***

8. Applicant's arguments see pages 4-8, filed 12/07/05, with respect to the rejection(s) of claim(s) 1-7 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.
9. The 35 USC 112 rejections are withdrawn in view of the applicant's amendments and response (see page 4 of the 12/07/05 amendment).
10. The art rejection of Skoglund et al. (US 5,716,701) is withdrawn because the examiner has not pointed to anything that would teach or suggest what results would be affected by varying the styrene content.

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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Desai whose telephone number is 571-272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

APD

*Haivo*

**HAIVO  
PRIMARY EXAMINER**